

Amendment Under 37 CFR §1.116
S/N: 10/714,672

REMARKS

Entry of this Amendment is proper under 37 CFR §1.116, since no new claims or issues are raised and the only claim amendments are directed to clarification over wording alleged by the Examiner as lacking support in the specification.

Claims 21-32 are all the claims presently pending in the application. Claims 1-20 are canceled.

In response to the Examiner's response that the description in lines 16-21 of page 7 of the specification fails to fully support the contents of claims 26, 28, and 31, Applicants have clarified the wording of these claims and respectfully direct the Examiner's attention to the description at lines 12-19, wherein is clearly described that second stage search operations can be initiated for strong signals.

It is noted that the claim amendments, if any, are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicant specifically states that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 26, 28, and 21 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing the written description requirement and under 35 U.S.C. § 112, second paragraph, as allegedly indefinite. Applicants believe that the above claim amendments appropriately address these concerns and respectfully request that the Examiner reconsider and withdraw these rejections.

Claims 21-32 stand rejected under 35 U.S.C. § 103(a) as unpatentable over WO 02/37889 to Ramesh et al, further in view of US Patent Publication 2004/0058650 to Palenius et al., and further yet in view of US Patent No. 6,400,946 to Vazvan et al.

This rejection is respectfully traversed in the following discussion.

I. THE CLAIMED INVENTION

As described exemplarily in independent claim 21, the claimed invention is directed to a method of determining a most suitable cell during network acquisition for

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a cellular communications device, based on a characteristic of signals received from a plurality of cells, the signals from each cell being provided over a band of frequencies. A series of measurements are taken the characteristics for each frequency of a first frequency band, so as to obtain an average measurement value of the characteristic for each frequency of the first frequency band, wherein the series of measurements on the first frequency band are equally spaced in time, with equal time intervals therebetween. During the time intervals between measurements for the first frequency band, a series of measurements of the characteristic for each frequency of a second frequency band are taken. The first and second frequency bands operate in different operating modes.

As explained at line 28 of page 4 through line 16 on page 5, Applicants have recognized that the 3GPP specification requirement for five measurements for each frequency within the frequency band be obtained within 3 seconds as being equally spaced does not necessarily mean that each of the large number of measurements be equally spaced from each other. The present invention uses the realization that only the measurements conducted on the same frequency need to be equally spaced (lines 8-13 on page 5).

Moreover, as explained at lines 12-18 of page 3, this technique allows a second band of frequencies to be searched, either within the same RAT (radio technology) or in another RAT, as well as potentially having second-stage search operations begin before the completion of the five measurements.

As exemplarily shown in the Figure, during the four equal-time intervals 12,14,16,18 shown on the horizontal axis over which a first frequency 1 is to be measured five times A,B,C,D,E, the present inventors have recognized that all remaining frequencies (e.g., 2 through n, shown in the vertical axis) of the RAT under evaluation can be rapidly and sequentially measured immediately after each respective measurement A,B,C,D,E of the first frequency 1.

As further explained at lines 17-24 on page 5 (and reflected in the independent claims), there are exemplarily (at least) two bands of frequencies represented in the n = 546 frequencies shown in the vertical axis (e.g., the EGSM 900 band contains 172 frequencies, and the GSM 1800 band contains 374 frequencies).

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II. THE PRIOR ART REJECTION

Claims 21-32 stand rejected as obvious over Ramesh, further in view of Palenius, and further yet in view of Vazvan. The Examiner concedes that primary reference Ramesh fails to teach or suggest using a plurality of modes and relies upon secondary reference Palenius and tertiary reference Vazvan to complete the combination of elements described in the claimed invention.

Applicants respectfully submit that, as explained in their previous response, even if combined, the combination would not result in the claimed invention, since the improvement that is actually taught in tertiary reference Vazvan does not correspond to the deficiency that would be necessary to complete the combination described by the independent claims, absent impermissible hindsight. That is, in an objective evaluation, what Vazvan actually teaches is clearly an alternative manner of establishing connection in a multimode communication system. The Examiner improperly attempts to extract elements out-of-context from Vazvan.

More specifically, in the prior art evaluation, the Examiner considers that primary reference Ramesh fails to teach or suggest taking measurements for two frequency bands and points to secondary reference Palenius, and is understood as alleging that such feature would be an improvement for Ramesh “... *for purpose of efficient cell search.*”

In response, Applicants first submit that this rationale fails to be a reasonable rationale, since primary reference Ramesh already has an efficient cell search and adding the feature of searching two frequency bands would not provide any improvement in efficiency, absent clarification by the Examiner exactly how Ramesh's cell search method would thereby be improved.

However, even more significant, the Examiner concedes that Ramesh/Palenius fails to suggest using two different modes and points to tertiary reference Vazvan, alleging that one of ordinary skill in the art would have been motivated to further modify Ramesh “... *to include multimode operation for the purpose of integration and flexibility (as) taught by Vazvan in col. 3.*”

Thus, as best understood, the Examiner considers that the method of Vazvan would provide an improvement appropriate for Ramesh.

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In response, Applicants respectfully submit that Examiner incorrectly defines the improvement actually described in Vazvan and that the actual improvement taught in tertiary reference Vazvan does not correspond to the deficiency conceded by the Examiner. That is, the improvement that Vazvan actually teaches, as clearly described in the Abstract, is to establish a first connection to a first communication network using a first criterion and then establish a connection to a second communication network using a second criterion. Therefore, incorporation of the method of tertiary reference Vazvan into primary reference Ramesh would not provide the method of the claimed invention, since incorporating the sequential first and second connections into primary reference Ramesh would only defeat the purpose of Ramesh and would, therefore, be improper under the holding of *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984), as described in MPEP §2143.01: "*If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.*"

Accordingly, based on the above-recited *Gordon* holding, the rejection of record fails to establish a prima facie obviousness rejection, since, because Vazvan is not properly combinable with Ramesh, then there is at least one element of the claimed invention that has not been demonstrated.

Applicants submit that the fundamental flaw with the rejection currently of record is that it attempts to consider elements of the claimed invention as abstract ideas that can be freely extracted out-of-context from prior art references. Such analysis is clearly improper hindsight, since it merely uses the claimed invention as a roadmap and ignores how the prior art references actually implement the elements that are being redefined by the claimed invention to be a new combination of elements as based on a different perspective.

Stated slightly differently, although each element of a claimed invention may well already be known in the prior art, as is often true, merely being known does not imply that an element is thereby obviously incorporated into any and all other combinations of other elements.

In fact, tertiary reference Vazvan clearly demonstrates that the element of "two different operating modes" in a cellular communication system can be implemented in a combination of elements that is clearly quite different from the combination defined
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in the claimed invention. Attempting to extract the element of “two different operating modes” as an abstract idea from Vazvan and out of the context of Vazvan’s method, as the Examiner does in the present evaluation, clearly and improperly relies upon the disclosure of the present application as the sole objective basis for the conclusion of obviousness for the claimed combination of elements.

The Examiner reasonably points to the holding in *KSR* as stating that, if the missing element is known in the art as a substitution or as an improvement, then the claimed combination can objectively be considered as obvious. However, as explained above, this requirement that the Examiner provide objective evidence that a prior art reference merely includes a missing element does not thereby demonstrate that the missing element is known to be a substitution or an improvement, particularly when the missing element is being taken out-of-context from the prior art reference.

That is, relative to tertiary reference Vazvan, used by the Examiner as demonstrating different communication systems, the Examiner clearly attempts to use this reference because of its demonstration of connecting to a second system after having connected initially to a first system. However, this level of abstraction taken out of context of Vazvan itself does not provide the claimed invention.

It is clear from the Abstract alone that Vazvan clearly requires that the mobile terminal first establish a connection with an initial system, using a first criterion, before using a second criterion to change to connect to a second system. In contrast, primary reference Ramesh clearly and inherently does not use two selection criteria. Therefore, it is clear that primary reference Ramesh is inherently not compatible with the feature relied upon from tertiary reference Vazvan, as viewed from the perspective of Vazvan itself.

Hence, turning to the clear language of the claim language, in Ramesh there is no teaching or suggestion of: “A method of determining a most suitable cell during network acquisition ... during the time intervals between measurements for said first frequency band, taking a series of measurements of said characteristic for each frequency of a second frequency band, wherein said first and second frequency bands operate in different operating modes”, as required by independent claim 21.

Independent claim 23 has similar wording.

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Relative to recently-added independent claim 29, since tertiary reference Vazvan clearly teaches an alternative method of establish connection to a network, by first establishing a first connection in a first mode using a first criterion and then establishing a second connection to a second mode using a second criterion, there is no teaching or suggestion in Ramesh, even if modified by Vazvan, of: “A method of determining a most suitable cell and a most suitable mode for a cellular communication device capable of operating in at least two modes, each operating mode having a plurality of frequencies occupying a frequency band, said method comprising: for each time period of a predetermined number of successive time periods, sequentially taking measurements of a characteristic for each frequency of each frequency band for each operating mode said cellular communication device is capable, each said time period being equal in time; calculating an average values of said characteristic for each frequency of each frequency band; and selecting said most suitable cell and said most suitable mode based upon said average values.”

Therefore, Applicant submits that there are elements of the claimed invention that are not taught or suggested by Ramesh. Therefore, the Examiner is respectfully requested to withdraw this rejection.

III. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicant submits that claims 21-32, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

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The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date: 02/25/09

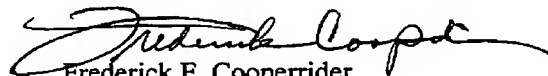


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CERTIFICATION OF TRANSMISSION

I certify that I transmitted via facsimile to (571) 273-8300 this Amendment under 37 CFR §1.116 to Examiner Shedrick on February 25, 2009.



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